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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/892,695 07/15/97 GRAY

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022798 HM12/0731  
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P O BOX 458  
ALAMEDA CA 94501

EXAMINER
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CANCELLATION	
ART UNIT	PAPER NUMBER

1642  
DATE MAILED:

07/31/01

*31*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/892,695

Applicant(s)

Gray et al

Examiner

Karen Canella

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1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-28, 37, and 38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-28 is/are allowed.
- 6) ☒ Claim(s) 37 is/are rejected.
- 7) ☒ Claim(s) 38 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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***Response to Amendment***

1. Please note that the examiner assigned to your application in the PTO has changed.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
3. Claim 26 has been amended. Claims 26-28, 37 and 38 are under consideration.
4. After reviewing the file, a discrepancy is noted between numbering of claims 37 and 38 and Appendix A submitted with the response filed 5/11/01. It is noted that originally filed claim 36 recited, "The method of claim 26, wherein the probe comprises a polynucleotide sequence as set forth in SEQ ID NO:9". Originally filed claim 37 recited, "The method of claim 26, wherein the probe comprises a polynucleotide sequence as set forth in SEQ ID NO:10". These claims were renumbered as 37 and 38 respectively, on 2/1/00 under rule 126 as two claims numbered as "1" were originally filed. However, Appendix A indicates the original numbering of 36 and 37 for these two claims. The examiner maintains that these claims are 37 and 38, although they have been inadvertently referred to as claims 36 and 37 in the previous office actions.
5. The rejection of claims 26-28 and 37 under 35 U.S.C. 102(a) as being anticipated by either Tanner et al (Clin Cancer Res, 1995, Vol. 1, pp. 1455-1461) or Tanner et al (Cancer Research, Aug 1996, Vol. 56, pp. 3441-3445), is maintained. Applicant has tried to obviate the rejection by substituting "consisting essentially of" for "comprising". However, a nucleotide consisting essentially of SEQ ID NO:9 would hybridize to the RMC20C001 probe disclosed by Tanner et al, as stated in the Office Action of 11/8/00. Amendment of claim 28 to be drawn to a method comprising contacting a mRNA or cDNA sample from a human patient with a probe consisting essentially of SEQ ID NO:9 and SEQ ID NO:10, in contrast to claim language encompassing any probe which hybridizes to sequences consisting of SEQ ID NO:9 and 10 is recommended. The

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rejection of claim 37 under 35 U.S.C. 102(a) as being anticipated by either Tanner et al (Clin Cancer Res, 1995, Vol. 1, pp. 1455-1461) or Tanner et al (Cancer Research, Aug 1996, Vol. 56, pp. 3441-3445), is maintained for reasons of record as claim 37 persists in reading on a polynucleotide comprising SEQ ID NO:9.

6. The provisional rejection of claims 37 and 38 under 35 U.S.C. 101, as claiming the same invention of claims 35 and 36 of co-pending Application No. 08/731,499, is withdrawn.

7. The provisional rejection of claims 26-28, 37 and 38 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 24-26, 35-36 and 38 of co-pending Application No. 08/731,499 is maintained for reasons of record.

8. The provisional rejection of claims 26-28, 37 and 38 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 26-28, 37-38, 56-57 and 61-63 of co-pending Application No. 08/785,532, is maintained for reasons of record.

9. Claims 37 and 38 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 37 and 38 are dependent on claim 26. Claim 26 is drawn to a method of screening for neoplastic cells comprising the use of a probe consisting essentially of SEQ ID NO:9 or SEQ ID NO:10. Claims 37 and 38 are drawn to probes comprising SEQ ID NO:9 and SEQ ID NO:10, respectively. Thus claims 37 and 38 are wider in scope than claim 26.

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*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

July 29, 2001

  
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